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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/525,491	03/15/2000	Mary Thomasma Tackbary	9203/031c3	9815
24283	7590	02/26/2004	EXAMINER	
PATTON BOGGS PO BOX 270930 LOUISVILLE, CO 80027			POND, ROBERT M	
			ART UNIT	PAPER NUMBER

3625

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/525,491

Applicant(s)

TACKBARY ET AL.

Examiner

Robert M. Pond

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The Applicant filed a request for reconsideration of all pending claims. All pending claims (45-80) were examined in this final Office Action.

The Applicant filed a Terminal Disclaimer to overcome the Double Patenting rejection. The acceptance of the Terminal Disclaimer is pending upon final approval. A separate correspondence will be mailed to the Applicant regarding status of the Terminal Disclaimer.

Response to Arguments

Applicant's arguments filed 11 November 2003 have been fully considered but they are not persuasive. The Applicant argues Cannon et al. teach a customer ordering a social expression card during a single session for a single recipient and that the combination of Cannon et al. and Gordon et al. do not teach or suggest a customer ordering multiple social expression cards for multiple recipients. This examiner maintains the position that Gordon et al. provide teachings pertinent to managing and delivering documents to multiple recipients in a single session.

The Applicant failed to adequately traverse the examiner's assertion of official notice (regarding express couriers). The examiner's taking of Official Notice

regarding common knowledge or well-known in the art statement is taken to be admitted prior (MPEP 2144.03 (C)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 1. Claims 45, 50-53, 57, 62-65, 69, and 74-77 are rejected under 35 USC 103(a) as being unpatentable over Cannon et al. (Paper #7, patent number 5,552,994), in view of Gordon et al. (Paper #9, patent number 4,994,926).**

Cannon et al. teach a system, method, means, databases, and programs for viewing, ordering, and printing social expression cards for customers who remotely order greeting cards over a computer network. Cannon et al. teach printing cards at the user location or at remote locations, a database defining the layout of selected cards by occasion (e.g. Birthday), displaying graphical images, personalizing messages, transacting multiple card orders, recipient information, envelop printing, and delivery modes. Cannon et al. teach a an order information database, multiple modes of delivery (e.g. mail or delivered as noted in prior art), order information storage and retrieval, and unique order identifiers to retrieve

orders (see at least abstract; Fig. 1 (15, 19); Fig. 3 (40, 50); 3a (36); Fig. 18 (52, 54, 66, 67, 68); col. 1, line 15 through col. 5, line 39). Cannon et al. teach storing order information in at least one database, the data in the order information database including recipient data records for a customer, and each recipient data records containing data that defines a recipient, and logically linking order information with card image, personalized messages, receiver and sender data, and order status data (see at least Fig. 19 (70, 71); col. 17, lines 3-8; lines 22-25; col. 18, lines 29-31). Cannon et al. teach linking the recipient data with social expression card data containing data which defines at least one social expression card, and forming linked data (see at least Fig. 19 (71, 72, 73); col. 18, lines 29-31). Cannon et al. further teach the following:

- Providing a customer interface to access databases and image files stored in a central data storage unit which may be accessed at a card display/order site facility and a card printing facility (see at least Fig. 18 (65, 66); col. 4, lines 56-59),
- Assigning each customer order with a unique order code and the order code being stored in the order information database and retrieved by the card printing facility for processing (see at least Fig. 19 (74); col. 4, lines 6-8; col. 18, line 59),
- Receiving an order initiated by a customer transmitting the order to a card printing site (see at least col. 17, lines 22-25;),

- Printing and shipping cards ordered by a customer or multiple customers, with order information stored in an order information database (see at least Fig. 19 (70, 71); Fig. 20b (79, 80)),
- Updating the order information to reflect the date the orders was processed and shipped (see at least Fig. 19 (85, 86); col. 19, lines 63-65), and
- Noting a known problem of card purchasers not remembering what card designs they have previously sent someone and being concerned about sending duplicates of cards previously sent (see col. 3, lines 50-55).

Cannon et al. teach all the above as noted under the 103(a) rejection and teach a) linking recipient data with greeting card data, b) the customer accessing the system to initiate delivery of a greeting card by a fulfillment center to a recipient, c) storing data in at least one database the information containing recipient data for said customer, and d) a plurality of recipient greeting card orders being placed into a order information database for daily processing (see at least Fig. 19 (70, 71); Fig. 20(b) (79, 80); col. 18, lines 34-36, 42-45; col. 19, lines 17-22), but are unclear as to whether the plurality of recipient data in the order information database belongs to the same sender. Gordon et al. teach a pertinent problem of providing a more practical means of initiating delivery of information to a plurality of recipients. Gordon et al. teach providing a practical

means for fax machine users to automatically fax documents to multiple destinations, and further teach this as an advantage since it only ties up a broadcast user's machine for one outgoing transmission (see at least col. 3, lines 48-58). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Cannon et al. to provide a more practical means of initiating delivery to a plurality of recipients in a single process as taught by Gordon et al., in order to eliminate singly repeated start and stop processes associated with each separate greeting card order, and thereby attract more customers to the service due the additional convenience.

2. **Claims 46-47, 58-59, and 70-71 are rejected under 35 USC 103(a) as being unpatentable over Cannon et al. (Paper #7, patent number 5,552,994) and Gordon et al. (Paper #9, patent number 4,994,926), as applied to Claims 45, 57, and 69, and in further view of Official Notice (regarding express couriers).**

Cannon et al. and Gordon et al. teach all the above as noted under the 103(a) rejection and further teach using mail or other purchaser delivery, but do not specifically disclose indicating to the customer multiple modes of delivery. This examiner takes the position that it is old and well-known that consumers and businesses use express couriers as alternative modes of mail or package delivery under circumstances where urgent delivery is required to meet a certain delivery date or to expedite delivery once past a certain delivery date. Therefore

it would have been obvious to one of ordinary skill in the art at time of invention to modify the system, method, and means of Cannon et al. and Gordon et al. to provide the customer with multiple modes of delivery as taught by Official Notice, in order to better meet customer delivery requirements, and thereby attract repeat customers.

- 3. Claims 48-49, 60-61, and 72-73 are rejected under 35 USC 103(a) as being unpatentable over Cannon et al. (Paper #7, patent number 5,552,994), and Gordon et al. (Paper #9, patent number 4,994,926), as applied to Claims 45, 57, and 69, and in further view of Hayes (Paper #7, PTO-892, Item: U).**

Cannon et al. and Gordon et al. teach all the above as noted under the 103(a) rejection and further electronic shopping, ordering, and delivering social expression cards remotely or from a greeting card shop, but do not disclose selecting a gift to be included with the card. Hayes teaches Bullock & Jones combining a gift with a card selected through a mail-order catalog shopping service that offers various forms of electronic shopping to better service customers. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Cannon et al. and Gordon et al. to provide a card and gift combination as taught by Hayes, in order to provide electronic shoppers a social occasion service capable of providing customers with a complete gift purchasing and card giving service emulating

catalog services or in-store experiences, and thereby attracting more customers to the site.

- 4. Claims 54-56, 66-68, and 78-80 are rejected under 35 USC 103(a) as being unpatentable over Cannon et al. (Paper #7, patent number 5,552,994) and Gordon et al. (Paper #9, patent number 4,994,926), as applied to Claims 45, 57, and 69, and in further view of Chartock (Paper #7, PTO-892, Item: V) and Mail List Management (a collection of articles cited in Paper #7, PTO-892, Items: W and X).**

Cannon et al. and Gordon et al. teach all the above as noted under the 103(a) rejection and teach a) desktop publishing systems (e.g. Pagemaker, QuarkXpress) allowing users to create custom publications, newsletters, brochures, b) using desktop publishing systems to create custom greeting cards, invitations, and business cards (see at least col. 2, lines 39-47), and c) using a mail management program (col. 18, line 25), but do not disclose the use of a mailing list of recipients or importing a mailing list. Chartock teaches desktop publishing and word processing being unified, and further teaches mail list management being integrated into desktop publishing-word processing products (see Item: V, page 1). Mail List Management teaches List&Mail, a mail list manager that allows users to create separate sub-lists with addresses drawn from the main file list (see Item: W, pages 8-9), and importing mail lists from external sources (e.g. Label Master, List Pro II, Mail-Track-II) (see at least Item:

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W, pages 7, 10, and 12). Mail List Management teaches desktop publishing systems to create newsletters and mailing lists comprising employees, potential customers, sales representatives, distributors, editors of appropriate business or trade publications, and influential friends and colleagues (see Item: X, pages 1-2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Cannon et al. and Gordon et al., to provide mail list application management features that support list creation, management, and list importation as taught by Chartock and Mail List Management, in order to provide more convenience to the customer in managing recipient lists, and thereby attract more customers to the site.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Vincent Millin** can be reached on 703-308-1065.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

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Commissioner of Patents and Trademarks

Washington D.C. 20231

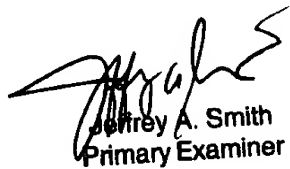
or faxed to:

703-872-9306 (Official communications; including After Final

communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

RMP
February 23, 2004


Jeffrey A. Smith
Primary Examiner